

## **REMARKS**

### **I. Introduction**

Claims 13-18, 20-21 and 23-27 are currently pending in the present application after cancellation of claims 19 and 22.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). Applicants also note with appreciation the acceptance of drawings and consideration of the Information Disclosure Statement which were previously submitted.

### **II. Rejection of Claims 13-15, 17, 22-25 and 27 under 35 U.S.C. § 102(b)**

Claims 13-15, 17, 22-25 and 27 are rejected under 35 U.S.C. § 102(b) as being anticipated by Maurinus (EP 0585186). Claim 22 has been canceled.

In order to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)). To the extent that the Examiner may be relying on the doctrine of inherent disclosure, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherence of that result or characteristic.

Amended independent claim 13 recites, in relevant parts, the following: (i) a first optical functional element and a second optical functional element, wherein the first optical

functional element includes an artificial light source, and wherein the second optical functional element includes a radiation-sensitive sensor surface; and (ii) the housing is a completely enclosed, integral unit, wherein the first and second optical functional elements are fully enclosed within the housing. Amended independent claims 23 and 25 recite substantially similar features as the above-recited features of claim 13. Maurinus does not suggest anything about the above-recited features of claim 13, and therefore independent claims 13, 22 and 25, as well as dependent claims 14-15, 17, 23-25 and 27, are allowable over Maurinus.

### **III. Rejection of Claim 16 under 35 U.S.C. § 103(a)**

Claim 16 is rejected under 35 U.S.C. § 103(a) as being rendered obvious by Maurinus in view of Marman (U.S. 5,026,990).

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to [modify] the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id., at 1396. To the extent that the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Claim 16 depends on claim 13. As discussed above, Maurinus does not suggest the

following features of parent claim 13: (i) a first optical functional element and a second optical functional element, wherein the first optical functional element includes an artificial light source, and wherein the second optical functional element includes a radiation-sensitive sensor surface; and (ii) the housing is a completely enclosed, integral unit, wherein the first and second optical functional elements are fully enclosed within the housing. In addition, Marman similarly fails to suggest the above-recited features of claim 13. Therefore, claim 13 and dependent claim 16 are allowable over the overall teachings of Maurinus and Marman.

#### **IV. Rejection of Claim 18 under 35 U.S.C. § 103(a)**

Claim 18 is rejected under 35 U.S.C. § 103(a) as being rendered obvious by Maurinus in view of Rothley (U.S. 6,710,348).

Claim 18 depends on claim 13. As discussed above, Maurinus does not suggest the following features of parent claim 13: (i) a first optical functional element and a second optical functional element, wherein the first optical functional element includes an artificial light source, and wherein the second optical functional element includes a radiation-sensitive sensor surface; and (ii) the housing is a completely enclosed, integral unit, wherein the first and second optical functional elements are fully enclosed within the housing. In addition, Rothley similarly fails to suggest the above-recited features of claim 13. Therefore, claim 13 and dependent claim 18 are allowable over the overall teachings of Maurinus and Rothley.

#### **V. Rejection of Claims 19-21 under 35 U.S.C. § 103(a)**

Claims 19-21 are rejected under 35 U.S.C. § 103(a) as being rendered obvious by Maurinus. Claim 19 has been canceled.

Claim 20, which depends on claim 13, recites that “the artificial light source is a light emitting diode.” Claim 21, which also depends on claim 13, recites that “the artificial light source is a diode emitting infrared light” (claim 21). As discussed above, Maurinus does not suggest the following features of parent claim 13: (i) a first optical functional element and a second optical functional element, wherein the first optical functional element includes an artificial light source, and wherein the second optical functional element includes a radiation-sensitive sensor surface; and (ii) the housing is a completely enclosed, integral unit, wherein the first and second optical functional elements are fully enclosed within the housing.

Therefore, claim 13 and dependent claims 20-21 are allowable over the overall teachings of Maurinus.

Independent of the above, to the extent the Examiner contends in connection with claim 20 that “Maurinus discloses a prior art IC element having a lens comprising an LED as an active optical element (col. 3, lines 20),” it appears the Examiner is referring to the citation of U.S. 4,419,722 and U.S. 4,471,414 found in col. 3, l. 5-9 of Maurinus, which section merely mentions “assemblies for holding light emitting diodes (LEDs) in apertures provided in printed circuit boards,” but does not actually mention any “lens comprising an LED.” In addition, the actual disclosures of U.S. 4,419,722 and U.S. 4,471,414 do not suggest any “lens comprising an LED.” For at least this additional reason, dependent claim 20 is allowable over the overall teachings of Maurinus.

**VI. Rejection of Claim 26 under 35 U.S.C. § 103(a)**

Claim 26 is rejected under 35 U.S.C. § 103(a) as being rendered obvious by Maurinus in view of Eggers (U.S. 2006/0038885).

Claim 26 depends on claim 25, which recites substantially similar features as the features of claim 13. As discussed above, Maurinus does not suggest the following features of parent claim 25: (i) a first optical functional element and a second optical functional element, wherein the first optical functional element includes an artificial light source, and wherein the second optical functional element includes a radiation-sensitive sensor surface; and (ii) the housing is a completely enclosed, integral unit, wherein the first and second optical functional elements are fully enclosed within the housing. In addition, Eggers similarly fails to suggest the above-recited features of claim 25. Therefore, claim 25 and dependent claim 26 are allowable over the overall teachings of Maurinus and Eggers.

**VII. Conclusion**

In view of all of the above, it is respectfully submitted that all of the presently pending claims under consideration are in allowable condition. Prompt reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,

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